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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,062	03/28/2001	Mary Smiley	42390P10856	4052

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EXAMINER

LAYE, JADE O

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,062

Applicant(s)

SMILEY ET AL.

Examiner

Jade O. Laye

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-5, 9-12, 14-18, 20, 22-24, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Carr. (US Pat. Pub. No. 2003/0133043).

As to claim 1, Carr discloses an enhancement distribution system, which converts the enhancement data into a second format compatible with the data network of the client side and delivers the data to said client. (Paragraphs [0001, 0002, 0013, 0014, 0025, 0030, 0031, 0032, 0034, 0050]). Accordingly, Carr anticipates each and every limitation of claim 1.

Claims 9, 14, 17, 20, and 22 correspond to the method claim 1. Therefore, each is analyzed and rejected as previously discussed.

As to claim 2, Carr further teaches his system receives the television broadcast and then, extracts the enhancement data from said broadcast. (Paragraphs [0013, 0014, 0030]). Accordingly, Carr anticipates each and every limitation of claim 2.

Claim 23 corresponds to the method claim 2. Thus, it is analyzed and rejected as previously discussed.

As to claim 3, Carr further teaches his system is capable transmitting enhanced ATVEF encoded web page content. (Paragraphs [0002, 0003]). Accordingly, Carr has anticipated each and every limitation of claim 3.

Claim 18 corresponds to the method claim 3. Thus, it is analyzed and rejected as previously discussed.

As to claim 4, Carr's system is capable of "pushing" converted enhancement data to the client. Pushing is simply a data distribution technology, in which data is automatically provided to a user (i.e., delivered without the user requesting it). Accordingly, Carr's system is capable of distributing streaming data and its accompanying enhancement data without the client requesting the broadcast be provided. (Paragraph [0002]). Therefore, Carr anticipates each and every limitation of claim 4.

Claims 11 and 24 correspond to the method claim 4. Thus, they are analyzed and rejected as previously discussed.

As to claim 5, Carr teaches his system is capable of allowing the user to "pull" data to the client side. Pulling is simply the technology, which requires a user to request information before it is provided. For example, when an Internet user surfs the net, he or she is essentially pulling web content from a server because the page he receives was requested. Carr teaches his system is capable of supplying content from a server (Figs. 1A & 1B) and a user has the option of viewing/not viewing the accompanying enhancement data. (Paragraphs [0003, 0030, 0050]). Therefore, in one embodiment of the Carr invention, a user is not automatically sent the enhancement data, rather, he or she must request/download it via the Internet. Accordingly, Carr anticipates each and every limitation of claim 5.

Claim 25 corresponds to the method claim 5. Thus, it is analyzed and rejected as previously discussed.

As to claim 10, Carr discloses the receivers can be coupled to servers, which supply enhancement data from the Internet. (Paragraphs [0016, 0031]). Accordingly, Carr anticipates each and every limitation of claim 10.

As to claim 12, Carr discloses the receivers can be coupled to servers, which supply enhancement data from the Internet. (Paragraphs [0016]). Accordingly, Carr anticipates each and every limitation of claim 12.

As to claim 15, Carr further teaches the television broadcaster can also broadcast the enhancement data. (Paragraph [0013]). Thus, Carr anticipates each and every limitation of claim 15.

As to claim 16, Carr further teaches the enhanced broadcast can contain an audiovisual component and ATVEF data. (Paragraph [0013]). Moreover, the client side receivers can extract the enhancement data from the broadcast. (Paragraphs [0014, 0030]). Accordingly, Carr anticipates each and every limitation of claim 16.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 6-8, 13, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carr in view of Reynolds et al. (US Pat. Pub. No. 2002/0138852).

Claim 6 recites the method of claim 1, further comprising:

- a. inspecting a client profile associated with the client; and
- b. determining the second format based at least in part on said inspecting.

As discussed above, Carr anticipates each and every limitation of claim 1, but fails to recite the limitations of claim 6. However, within the same field of endeavor, Reynolds et al disclose a similar system capable of analyzing the client side receiver capabilities in order to determine what transmission format should be utilized. (Paragraphs [0007, 0013]). This, in

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essence, forms part of a user profile because each user could have different receiver capabilities. Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Carr and Reynolds in order to provide a system, which is more effective in servicing the end-user through an analysis of a user profile. (Note: The examiner recognizes that an alternative interpretation of "client profile" could encompass user viewing preferences and the like. There are a number of analogous references disclosing this well-known method of transmission and, in the alternative, a rejection would be made accordingly.)

Claim 19 corresponds to the method claim 6. Thus, it is analyzed and rejected as previously discussed.

Claim 7 recites the method of claim 6, further comprising:

- a. providing plural conversion formats including the second format;
- b. associating delivery prices with each of said plural formats; and
- c. selecting the second format of said plural formats based at least in part on said associated delivery prices and said inspecting the client profile.

As discussed above, the combined systems of Carr and Reynolds disclose all limitations of claim 6 and Carr further discloses that his system is capable of providing plural conversion formats. (Paragraph [0002]). In addition, Reynolds further teaches that pricing information can be associated with various delivery formats and thus, used as a basis for selecting said format. (Paragraphs [0030, 0041]). Therefore, the combined systems of Carr and Reynolds contain all limitations of claim 7.

Claim 8 corresponds to the method claim 7. Thus, it is analyzed and rejected as previously discussed.

Claim 13 recites the method of claim 9, wherein the second format is selected from a set of formats consisting of: a streaming media format, a hypertext transport protocol (HTTP) format, a Java-type format, a JavaScript-type encoding format, a tag based encoding format, and a web page format. As discussed above, Carr contains all limitations of claim 9, and further teaches said second format can be streaming media ([0005,0018]), HTTP ([0021]), or a web page ([0002]). But, Carr fails to disclose the remaining limitations. However, within the same field of endeavor, Reynolds discloses a similar system capable of transmitting Java-type, JavaScript-type, and HTML formats (i.e., tag based). ([0020 & Table 1]). Therefore, the combined systems of Carr and Reynolds contain all limitations of claim 13.

Claim 21 corresponds to the method claim 13. Thus, it is analyzed and rejected as previously discussed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Carr (US Pat. No. 6,557,172) discloses a system capable of communicating enhancement data in layers.
- b. Blacketter et al (US Pat. No. 6,560,777) disclose a system capable of broadcasting enhancement data.

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- c. Thomas et al (US Pat. Pub. No. 2002/0023270) disclose a three-part architecture for digital television data broadcasting.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (703)308-6107. The examiner can normally be reached on Mon. 7:30am-3pm, Tues.-Fri. 7:30-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703)305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner's Initials JL
January 27, 2005.


NGOC-YEN VU
PRIMARY EXAMINER